



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/521,646 | 03/08/2000 | Takahisa Hatakeyama | 1924.63656 | 1446 |

7590 09/09/2003

PATRICK G BURNS
GREEN BURNS & CRAIN LTD
300 S WACKER DRIVE
25TH FLOOR
CHICAGO, IL 60606

EXAMINER

GREENE, DANIEL L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3621

DATE MAILED: 09/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/521,646

Applicant(s)

HATAKEYAMA ET AL.

Examiner

Daniel L. Greene

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-169 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's arguments, see Amendment C, filed 7/28/03, with respect to the rejection(s) of claim(s) 1-15 under Ginter '193 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Iwayama et al. US 5,832,083 [Iwayama '083].

The Applicant argues that the 102 Rejection utilizing Ginter '193 does not specifically disclose a storage device, a separate reproduction device and two stages of decoding to display the licensed data. Ginter '193 discloses storing digital information in the memory of a first device and if the copy control permits it, copy and store the information on a second device that includes a memory and an audio/video output. Col. 322, lines 20-45. Ginter '193 further teaches about the encryption/decryption of the digital files between devices. Col. 323, lines 40-50. The specific delineation/description of the devices specified by Ginter '193 leaves room for interpretation and speculation on the locations of the various devices Ginter '193 describes. Iwayama '083 teaches about a data storing section, an information converting section, and a utilization-permitting device. Combining Iwayama '083 with Ginter '193 in a 103 Rejection would address the Applicant's argument and also to preclude an Official Notice in conjunction with Ginter '193 to address the Applicant's arguments.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter '193, and further in view of Iwayama et al. US Patent 5,832,083 [Iwayama '083].

As per Claim 1:

Ginter'193 discloses:

a user unit which enables the user to use the content; Fig. 7, Col. 60-62.

a setting unit which sets a license as a structure expressed by a combination of logic sums and logic product of a plurality of partial licenses for the content based on the ID information of the physical elements of said user unit including the media used in said user unit and the ID information of the user; Fig. 5b, Col. 59, lines 1-37.

a usage control unit which controls the usage of the content by said user unit by using license information encrypted, at the request of the user unit intending to use the content, from the license set by said setting unit and a content decode key by the ID information of the physical elements through which the license information is passed in sequence until the content is decoded by use of the content decode key. Fig. 10, Col.79, lines23-67, Col. 80, 81& 82.

Art Unit: 3621

Ginter '193 discloses the claimed invention except for the specific detail of separation of function utilizing a plurality of physical elements. Iwayama '083 teaches that it is known in the art to provide a plurality of physical elements to store, utilization permitting, and information converting. Col. 2-3, lines 1-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the secure transaction management system of Ginter '193 with the plurality of physical elements of Iwayama '083, in order to effectively accomplish the separation of function as described by Ginter '193 to a plurality of physical elements.

As per Claim 2:

Ginter'193 and Iwayama '083 disclose all the limitations of claim 1.

Ginter'193 further discloses:

wherein the partial licenses set by said setting unit include an accounting condition constituting the condition for a category changing with a usage state of said user unit and the user. Fig.13, Col. 105, lines 15-67, Col. 106.

As per Claim 3:

Ginter'193 and Iwayama '083 disclose all the limitations of claim 1.

Ginter'193 further discloses:

in which said user unit decodes the license information sent in accordance with the content usage request, based on the ID information of the physical elements of the user unit when the license information is passed to each of the physical elements in

Art Unit: 3621

sequence, and in the case where the license conditions are satisfied, the encrypted content is decoded by use of the content decode key. Col. 263 & 264.

As per Claim 4:

Ginter'193 and Iwayama '083 disclose all the limitations of claim 1.

Ginter'193 further discloses:

wherein said usage control unit encrypts by multiplexing the ID information of the physical elements corresponding to the partial licenses of the license in the case where an interface of the partial licenses is described by the logic product. Col. 268, lines 28-61.

As per Claim 5:

Ginter'193 and Iwayama '083 disclose all the limitations of claim 1.

Ginter'193 further discloses:

wherein the physical elements include those included in other physical elements. Fig.78, Col. 290,291.

Ginter '193 discloses the claimed invention except for the specific detail of separation of function utilizing a plurality of physical elements. Iwayama '083 teaches that it is known in the art to provide a plurality of physical elements to store, utilization permitting, and information converting. Col. 2-3, lines 1-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the

secure transaction management system of Ginter '193 with the plurality of physical elements of Iwayama '083, in order to effectively accomplish the separation of function as described by Ginter '193 to a plurality of physical elements.

As per Claim 6:

Ginter'193 and Iwayama '083 disclose all the limitations of claim 1.

Ginter'193 further discloses:

a content server, which holds the content encrypted by the authorized information supplier on an open network, and sends the encrypted content to said user unit upon receipt of a request to distribute the content from said user unit. Fig. 78, Col. 284, 285.

As per Claim 7.

Ginter'193 discloses:

a user unit which requests usage of the content, and decodes the encrypted content using a content decode key in the case of satisfying license conditions obtained by decoding license information sent in accordance with a content usage request, based on ID information of physical elements of the user unit when the license information is passed to each of the physical elements in sequence;

a setting unit which sets a license expressed as a structure by a combination of logic sums and logic products of a plurality of partial licenses for the content based on

Art Unit: 3621

the ID information of the physical elements of said user unit including media used in said user unit and ID information for the user;

a conditions storage unit, which stores the license conditions, set by said setting unit;

a holding unit which holds said content decode key;

an extraction unit which receives the content usage request from said user unit and extracts the license conditions and said content decode key corresponding to said user unit; and

a production unit which produces the license information by encrypting the license conditions and said content decode key based on the ID information of the physical elements through which the license information is passed in sequence until the content is decoded by use of the content decode key and sends the license information to said user unit. Fig. 79, Col. 301-304.

Ginter '193 discloses the claimed invention except for the specific detail of separation of function utilizing a plurality of physical elements. Iwayama '083 teaches that it is known in the art to provide a plurality of physical elements to store, utilization permitting, and information converting. Col. 2-3, lines 1-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the secure transaction management system of Ginter '193 with the plurality of physical elements of Iwayama '083, in order to effectively accomplish the separation of function as described by Ginter '193 to a plurality of physical elements.

As per Claim 8.

Ginter'193 discloses:

a request unit which transmits ID information of physical elements of said content usage apparatus and ID information of the user to an external content management apparatus which manages the content in response to a content usage request; a unit which decodes license information transmitted by said content, management apparatus in response to the content usage request, using the ID information of the physical elements of said content usage apparatus when the license information is passed to each of the physical elements in sequence, and determines license conditions and a content decode key; and a unit which decodes the content using the content decode key when permitted upon determination that the license has been obtained. Fig.35, Col.161 & 162.

Ginter '193 discloses the claimed invention except for the specific detail of separation of function utilizing a plurality of physical elements. Iwayama '083 teaches that it is known in the art to provide a plurality of physical elements to store, utilization permitting, and information converting. Col. 2-3, lines 1-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the secure transaction management system of Ginter '193 with the plurality of physical elements of Iwayama '083, in order to effectively accomplish the separation of function as described by Ginter '193 to a plurality of physical elements.

Art Unit: 3621

As per Claim 9.

Ginter'193 discloses:

transmitting ID information of physical elements of said content usage apparatus and ID information of a user to an external content management apparatus, which manages the content in accordance with a content usage request; determining license conditions and a content decode key by decoding license information transmitted by said external content management apparatus in response to the content usage request, using the ID information of the physical elements of said content usage apparatus when the license information is passed to each of the physical elements in sequence; and decoding the content using the content decode key when permitted upon determination of the license conditions. Fig.78, Col. 290,291,292.

Ginter '193 discloses the claimed invention except for the specific detail of separation of function utilizing a plurality of physical elements. Iwayama '083 teaches that it is known in the art to provide a plurality of physical elements to store, utilization permitting, and information converting. Col. 2-3, lines 1-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the secure transaction management system of Ginter '193 with the plurality of physical elements of Iwayama '083, in order to effectively accomplish the separation of function as described by Ginter '193 to a plurality of physical elements.

As per Claim 10.

Ginter'193 discloses:

a unit which determines, in response to a content usage request, license conditions and a content decode key by decoding license information for the content based on ID information of physical elements of said content usage apparatus when the license information is passed to each of the physical elements in sequence; and a unit which decodes the content by use of the content decode key when permitted upon satisfaction of the license conditions determined. Fig.78, Col. 290,291,292.

Ginter '193 discloses the claimed invention except for the specific detail of separation of function utilizing a plurality of physical elements. Iwayama '083 teaches that it is known in the art to provide a plurality of physical elements to store, utilization permitting, and information converting. Col. 2-3, lines 1-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the secure transaction management system of Ginter '193 with the plurality of physical elements of Iwayama '083, in order to effectively accomplish the separation of function as described by Ginter '193 to a plurality of physical elements.

As per Claim 11.

Ginter'193 discloses:

determining, in response to a content usage request, license conditions and a content decode key by decoding license information of the content based on ID

Art Unit: 3621

information of physical elements of said content usage apparatus when the license information is passed to each of the physical elements in sequence; and decoding the content using the content decode key when permitted upon determination of the license conditions. Fig.78, Col. 290,291,292.

Ginter '193 discloses the claimed invention except for the specific detail of separation of function utilizing a plurality of physical elements. Iwayama '083 teaches that it is known in the art to provide a plurality of physical elements to store, utilization permitting, and information converting. Col. 2-3, lines 1-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the secure transaction management system of Ginter '193 with the plurality of physical elements of Iwayama '083, in order to effectively accomplish the separation of function as described by Ginter '193 to a plurality of physical elements.

As per Claim 12.

Ginter'193 discloses:

transmitting ID information of physical elements of said content usage apparatus and ID information of the user to an external content management apparatus, which manages the content in accordance with a content usage request; determining license conditions and a content decode key by decoding license information transmitted by said external content management apparatus in response to the content usage request, using the ID information of the physical elements of said

Art Unit: 3621

content usage apparatus when the license information is passed to each of the physical elements in sequence; and
decoding the content using the content decode key when permitted upon determination of the license conditions. Fig.35, Col.161 & 162.

Ginter '193 discloses the claimed invention except for the specific detail of separation of function utilizing a plurality of physical elements. Iwayama '083 teaches that it is known in the art to provide a plurality of physical elements to store, utilization permitting, and information converting. Col. 2-3, lines 1-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the secure transaction management system of Ginter '193 with the plurality of physical elements of Iwayama '083, in order to effectively accomplish the separation of function as described by Ginter '193 to a plurality of physical elements.

As per Claim 13.

Ginter'193 discloses:

transmitting ID information of physical elements of said content usage apparatus and ID information of the user to an external content management apparatus, which manages the content in accordance with a content usage request;

determining license conditions and a content decode key by decoding license information transmitted by said external content management apparatus in response to the content usage request, using the ID information of the physical elements of said

content usage apparatus when the license information is passed to each of the physical elements in sequence; and

decoding the content using the content decode key when permitted upon determination of the license conditions. Fig.35, Col.161 & 162.

Ginter '193 discloses the claimed invention except for the specific detail of separation of function utilizing a plurality of physical elements. Iwayama '083 teaches that it is known in the art to provide a plurality of physical elements to store, utilization permitting, and information converting. Col. 2-3, lines 1-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the secure transaction management system of Ginter '193 with the plurality of physical elements of Iwayama '083, in order to effectively accomplish the separation of function as described by Ginter '193 to a plurality of physical elements.

As per Claim 14.

Ginter'193 discloses:

determining, in response to a content usage request, license conditions and a content decode key by decoding license information of the content based on ID information of physical elements of said content usage apparatus when the license information is passed to each of the physical elements in sequence; and decoding the content using the content decode key when permitted upon determination of the license conditions. Fig.78, Col. 290,291,292.

Ginter '193 discloses the claimed invention except for the specific detail of separation of function utilizing a plurality of physical elements. Iwayama '083 teaches that it is known in the art to provide a plurality of physical elements to store, utilization permitting, and information converting. Col. 2-3, lines 1-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the secure transaction management system of Ginter '193 with the plurality of physical elements of Iwayama '083, in order to effectively accomplish the separation of function as described by Ginter '193 to a plurality of physical elements.

As per Claim 15.

Ginter'193 discloses:

determining, in response to a content usage request, license conditions and a content decode key by decoding license information of the content based on ID information of physical elements of said content usage apparatus when the license information is passed to each of the physical elements in sequence; and decoding the content using the content decode key when permitted upon determination of the license conditions. Fig.78, Col. 290,291,292.

Ginter '193 discloses the claimed invention except for the specific detail of separation of function utilizing a plurality of physical elements. Iwayama '083 teaches that it is known in the art to provide a plurality of physical elements to store, utilization

Art Unit: 3621

permitting, and information converting. Col. 2-3, lines 1-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the secure transaction management system of Ginter '193 with the plurality of physical elements of Iwayama '083, in order to effectively accomplish the separation of function as described by Ginter '193 to a plurality of physical elements.

As per claim 16:

Ginter'193 discloses all the limitations of claim 15.

Ginter'193 further discloses:

wherein the license information includes accounting condition constituting the condition of a category changing with a usage state of said user unit and the user.

Fig.13, Col. 105, lines 15-67, Col. 106.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Art Unit: 3621

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703-306-5539. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

8/26/03

DLG


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600